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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/477,278

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12/17/2004

Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
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EXAMINER

PHAN, TRI H

ART UNIT

PAPER NUMBER

2661

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/477,278

Applicant(s)

HSU ET AL.

Examiner

Tri H. Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment/Arguments

1. This Office Action is in response to the Response/Amendment filed on August 3rd, 2004.

Claims 1-21 are now pending in the application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Manning et al.** (U.S.6,580,699).

- In regard to claims 1, 11, 16 and 21, **Manning** does disclose in Figs. 1-2, 5 and in the respective portions of the specification about the system, method and means for establishing an Radio-Packet data serving node 'R-P' ("*Packet Data Services Network*", 'PDSN') connection where the mobile station 'MS' roams from the control of the old base station controller 'BS-O' to the new base station controller 'BS-N' ("*moving from first infrastructure element to the second infrastructure element*"; For example see Figs. 1-2; col. 1, lines 12-24; col. 3, lines 50-56) for establishing the point-to-point ('PPP') connection with the PDSN (For example see Col. 3, Lines

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50-56); the MS stores necessary information such as PPP indicator, session ID, cell ID, etc. (*"list of identifiers"*); For example see col. 5, lines 12-23; col. 4, lines 18-26) and the related R-P connection, e.g. PPP session status (*"active or dormant state"*); wherein *"active state"* is the state where the mobile station is receiving or transmitting data and *"dormant state"* is just the state where the mobile station has nothing, e.g. data, to transmit or receive), and uses the registration message to send information about the PPP session status to the BS-N (*"transmitting the message from the mobile station"*); For example see Fig. 5; col. 2, lines 19-35; col. 5, lines 12-40) in order to construct the R-P connection when roaming into a new radio network. **Manning** fails to explicitly disclose about the *"number of network connections"* in the information transmitting to the new BS; however, **Manning** does disclose that the MS can have one or more session ID instances (*"IP instances"*) simultaneously (For example see col. 4, lines 18-28) therefore, it is obvious that the MS can send all the necessary information with the appropriated session IDs to the new BS, where the *"number of network connections"*, which is just the number counting from the session ID instances, are just the optional choices in the necessary transmitting information to the new BS. It is also obvious that the 'dormant' MS has *"dormant connections"* which provide by the PPP session status sent to the BS-N when roaming or idle (For example see Fig. 6; col.5, line 54 through col. 6, line 22).

- Regarding claims 2, 7, 12 and 17, **Manning** further discloses about the 'dormant' MS has PPP connections (For example see col. 6, lines 9-13).

- In regard to claims 3, 8, 13 and 18, **Manning** further discloses about the Packet data session nodes (*“first and second infrastructure elements are packet data service nodes”*; For example see Figs. 1-2; col. 3, Lines 32-41).

- Regarding claims 4, 9, 14 and 19, **Manning** further discloses about the R-P indicator, PDSN ID, Pre_cell ID, session ID (*“the service reference identifiers”*; For example see Figs. 1-2; col. 4, lines 18-26).

- In regard to claims 5, 10, 15 and 20, **Manning** further discloses about the PPP session indicator storing in the MS (*“indicator”*; For example see col. 2, lines 19-27; col. 5, lines 12-23) where it is obvious that the ‘dormant’ MS has *“dormant network connections”* which provide by the PPP session status (*“active or dormant state”*) sent to the BS-N when roaming or idle (For example see Fig. 6; col.5, line 54 through col. 6, line 22; wherein the MS can have one or more session ID instances or connections simultaneously as disclosed in col. 4, lines 18-26).

- Regarding claim 6, **Manning** discloses in Figs. 1-2, 5 and in the respective portions of the specification about the system, method and means for establishing an Radio-Packet data serving node ‘R-P’ (*“Packet Data Services Network”*, ‘PDSN’) connection where the mobile station ‘MS’ roams from the control of the old base station controller ‘BS-O’ to the new base station controller ‘BS-N’ (*“moving from first infrastructure element to the second infrastructure element”*; For example see Figs. 1-2; col. 1, lines 12-24; col. 3, lines 50-56) for establishing the point-to-point (*“PPP”*) connection with the PDSN (For example see Col. 3, Lines 50-56); the MS

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stores necessary information such as PPP indicator, session ID, cell ID, etc. (*"list of identifiers"*) and the related R-P connection, e.g. PPP session status (*"active or dormant state"*), and uses the registration message to send information about the PPP session status to the BS-N (*"transmitting the message from the mobile station"*); For example see Fig. 5; col. 2, lines 19-35; col. 5, lines 12-40) in order to construct the R-P connection when roaming into a new radio network. It is inherent that the MS has antenna (*"antenna"*) for transmitting and receiving call. It is also obvious that the MS has the *"processor"* and memory (*"processor-readable medium"*) in order to store necessary information sent to the BS-N or program (*"set of instructions"*) in order to perform the modulation for the receiving/transmitting RF signal (*"modulating signal"*) or performing methods as disclosed above. **Manning** fails to explicitly disclose about the *"number of network connections"* in the information transmitting to the new BS; however, **Manning** does disclose that the MS can have one or more session ID instances simultaneously (For example see col. 4, lines 18-28); therefore, it is obvious that the MS can send all the necessary information with the appropriated session IDs to the new BS, where the *"number of network connections"*, which is just the number counting from the session ID instances, are just the optional choices in the necessary transmitting information to the new BS. It is also obvious that the 'dormant' MS has *"dormant connections"* which provide by the PPP session status sent to the BS-N when roaming or idle (For example see Fig. 6; col.5, line 54 through col. 6, line 22).

Response to Arguments

4. Applicant's arguments filed on August 3rd, 2004 have been fully considered but they are not persuasive.

Applicant argues that **Manning** fails to disclose the limitation “*transmitting from the mobile station a message including a number of dormant network connections associated with the mobile station and a list of identifiers associated with the dormant network connections.*”. Examiner respectfully disagrees.

Manning does disclose in Figs. 1-2, 5 and in the respective portions of the specification about the system, method and means for establishing an Radio-Packet data serving node 'R-P' (“*Packet Data Services Network*”, 'PDSN') connection where the mobile station 'MS' roams from the control of the old base station controller 'BS-O' to the new base station controller 'BS-N' (“*moving from first infrastructure element to the second infrastructure element*”; For example see Figs. 1-2; col. 1, lines 12-24; col. 3, lines 50-56) for establishing the point-to-point ('PPP') connection with the PDSN (For example see Col. 3, Lines 50-56); the MS stores necessary information such as PPP indicator, session ID, cell ID, etc. (“*list of identifiers*”; For example see col. 5, lines 12-23; col. 4, lines 18-26) and the related R-P connection, e.g. PPP session status (“*active or dormant state*”; wherein “*active state*” is the state where the mobile station is receiving or transmitting data and “*dormant state*” is just the state where the mobile station has nothing, e.g. data, to transmit or receive), and uses the registration message to send information about the PPP session status to the BS-N (“*transmitting the message from the mobile station*”; For example see Fig. 5; col. 2, lines 19-35; col. 5, lines 12-40) in order to construct the R-P connection when roaming into a new radio network. **Manning** fails to explicitly disclose about the “*number of network connections*” in the information transmitting to the new BS; however, **Manning** does disclose that the MS can have one or more session ID instances (“*IP instances*”) simultaneously (For example see col. 4, lines 18-28); therefore, it is obvious that the MS can

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send all the necessary information with the appropriated session Ids to the new BS, where the “*number of network connections*”, which is just the number counting from the session ID instances, are just the optional choices in the necessary transmitting information to the new BS. It is also obvious that the 'dormant' MS has “*dormant connections*” or “*dormant state*”, e.g. the state where the mobile station does not receive or transmit data, but still maintain the PPP connection and the R-P connection (For example see Fig. 6; col.5, line 54 through col. 6, line 22); by providing the PPP session status or necessary stored information to the BS-N, when roaming or idle, for updating or establishing new R-P connection when needed (For example see col.2, lines 19-35) in order to maintain network reliability and efficiency as disclosed in col. 4, lines 44-50. Therefore, Examiner concludes that **Manning** teaches the arguable features.

In response to Applicant's argument that the references fail to show certain feature of Applicant's invention, it is noted that the feature upon which Applicant relies (i.e., a “dormant state”, which found in the Applicants' specification at page 9, lines 4-14) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993).

Regarding claims 1, 6, 11, 16 and 21, it recites the method for “*informing a packet data services network of dormant network connections associated with a mobile station ...*” when the mobile station roams from one to another infrastructure element; which comprises the step of “*transmitting from the mobile station a message ...*” that leaves a doubt as to the scope of the subject matter which applicant regards as the invention, because the person of ordinary skill in the art would not know where the “*method of informing packet*” ‘is applied to’ and there is no

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'where' for the transmitted message to go or receive (For example 'transmitting the message **from** the mobile station ... **to** ...'). Therefore, the claim will raise in question and fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-5,7-10,12-15 and 17-20 are rejected as in Part 3 above of this Office action and by virtue of their dependence from claims 1, 6, 11, 16.

Conclusion

5. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri H. Phan, whose telephone number is (703) 305-7444. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas W. Olms can be reached on (703) 305-4703.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office, whose telephone number is (703) 305-3900.



Tri H. Phan
December 13, 2004


**BRIAN NGUYEN
PRIMARY EXAMINER**